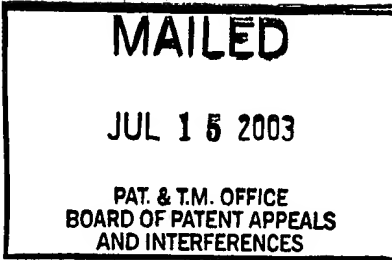


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte DAVID TIGHE
and
ANDREW WILLIAMS

Application No. 09/582,760

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on June 23, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

On June 30, 2000, appellants submitted a preliminary amendment (Paper No. 3). Attached thereto was another paper entitled "Information Disclosure Statement" (IDS) (no paper no.).

It is not apparent from the record whether the examiner considered the statement submitted or notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required. In addition, the IDS has not been physically entered onto the Contents page of the application file.

On February 4, 2003, an Order Returning Undocketed Appeal to Examiner was mailed (Paper No. 16) which advised the examiner that in view of the changes to 37 CFR § 1.193(b)(1), the entry of the examiner's Office communication mailed January 2, 2003 (Paper No. 15), was inappropriate.

37 CFR § 1.193(b)(1) was amended on December 1, 1997 and states:

§ 1.193 Examiner's answer and reply brief.

. . .

(b)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of such examiner's answer. . . . The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

On January 31, 2003, appellants submitted a Supplemental Reply Brief (Paper No. 17). In response, an examiner's Office communication was mailed on June 3, 2003 (Paper No. 19) which once again included a rebuttal of the position forth in the Supplemental Reply Brief.

Accordingly, the application is returned to the examiner:

1. for consideration of the IDS filed June 30, 2000 (no paper no.) and physical entry of this paper onto the Contents page of the application file;

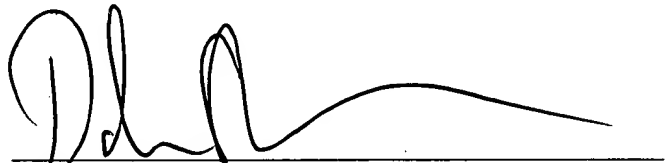
2. for appropriate notification to appellants regarding the Primary Examiner's decision of the IDS mailed June 30, 2000;

Application 09/582,760

3. for proper response to the Supplemental Reply Brief filed January 31, 2003 (Paper No. 17); and
4. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:



DALE SHAW
Program and Resource Administrator
(703) 308-9797

cc: Nixon & Vanderhye
1100 North Glebe Road
8th Floor
Arlington, VA 22201-4714

ds/psb/dm
RA030410